



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,381	09/27/1999	PRASAD Y. CHEBROLU	062891.0299	1545

7590 08/08/2003
BAKER & BOTTS LLP
2001 ROSS AVENUE
DALLAS, TX 752012980

EXAMINER

ENG, DAVID Y

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/406,381

Applicant(s)

CHEBROLU, PRASAD Y.

Examiner

DAVID Y. ENG

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10 and 28 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Thaweethai.

Claims 1, 3-9, 12-19, 21-27 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thaweethai.

Claims 2, 11, 20 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thaweethai in view of Bush.

Details of the rejection have already been set forth in the last Office action. The details are incorporated herein by reference thereto.

In the remarks directed to the 102 Rejection and the 103 Rejection based on Thaweethai alone, Applicants contended that the applied reference does not teach a memory operable to store a performance attribute for each modem and an allocation module operable to receive modem request and to select a modem for service according to the modem's performance attribute. As admitted by Applicants, Thaweethai teaches a system having a plurality of modems, a memory for storing modem capabilities and a Modem Pooling Control Function (MPCF) for receiving a modem request and for selecting a modem which meets the capability specified in the request. This is exactly what Applicants' invention does in claims 10 and 28. Applicants appear to contend that they use the term "attribute" and whereas Thaweethai uses the term "capabilities". Firstly, both attributes and capabilities are being used for selecting a modem to meet the requirements specified in the request. A modem would not perform

Art Unit: 2155

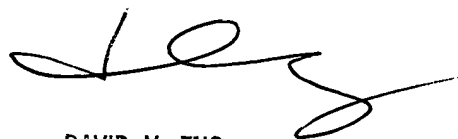
well if it does not have the capability. Secondly, it should be noted that all applicants, including Thaweethai, are allowed to be their own lexicographer. It appears that Applicants are looking for their claims in Thaweethai. Thirdly, Applicants fail to provide any arguments as to why the invention as claimed in claims 10 and 28 are patentably distinct over Thaweethai. The court held that simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability. In re Neilson, 816 F.2d 1567, 2 USPQ 1525 (Fed. Cir. 1987).

In regard to the rejection based on Thaweethai and Bush, Applicants disagree with the Examiner that monitoring performance attributes is obvious. It should be noted that the rejection is not made based on the Examiner's opinion. Rather, the rejection is based on Thaweethai in view of Bush. Bush clearly teaches monitoring and updating performance attributes (capable if perform well and not capable if does not perform well) of a device (disk drive or modem). It would have been obvious to a person of ordinary skill in the art to monitor and update the capability information or performance attributes in Thaweethai as taught by Bush such that the modem of Thaweethai can be selected based on more accurate information. Note that the purpose of update is to obtain latest information. Obviously, Thaweethai requires latest information in order to make a better selection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2155

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

A handwritten signature in black ink, appearing to read 'D. Eng', with a long horizontal stroke extending to the right.

DAVID Y. ENG
PRIMARY EXAMINER